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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,396	01/30/2004	Gerardus Adrianus Maria Verhoeven	MORIAS1	3794

7590 09/01/2005

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,396

Applicant(s)

VERHOEVEN, GERARDUS
ADRIANUS MARIA

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Steinmann (4,419,081). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.
3. Claims 8, 10-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (3,547,444). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.
4. Claims 8, 9, 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wadsworth (3,964,749). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinmann (4,419,081) in view of Williams (3,547,444). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.
7. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,547,444) in view of Mitchell (5,368,301). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.

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8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,547,444). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.

Response to Arguments

9. Applicant's arguments filed July 7, 2005 have been fully considered but are not deemed to be persuasive. Regarding the reference to Steinmann, the applicant argues that Steinmann is not directed to a puzzle nor does it disclose positioning an element with respect to a border having a predetermined shape. The applicant further argues that the edge elements on the cards are used for ensuring that the cards are properly aligned in edge to edge contact. Finally, the applicant argues that it is not possible to determine the value of N (the number of possible orientations with respect to the border) of the cards.

However, these arguments are not persuasive. The limitation for the elements to be a puzzle piece relates to the intended use of the device. Further, the elements of Steinmann could clearly be termed puzzle pieces since they involve the user to figure out a particular problem. Regarding the limitation for a border, it is noted that the claim fails to provide any specific limitations directed to the recited border. As such, the adjacent piece such as element 2 to element 1 would provide a border therefore.

Further, the predetermined shape of the pieces of Steinmann provide four possible orientations with respect to the border (adjacent element). The indicia of the pieces dictates the correct orientation of the pieces with respect to the border. Regarding the value of N of the cards or blocks of Steinmann, this value may be determined simply because the shape of the pieces of Steinmann provide four possible sides.

Regarding the reference to Williams, the applicant argues that these pieces are not used as parts of a puzzle. Further, the applicant argues that Williams does not provide a border for the pieces. However, these arguments are also not persuasive as again, the limitation “puzzle” relates to the intended use of the elements. Further, the elements of Williams could clearly be termed puzzle pieces since they involve the user to figure out a particular problem. Regarding the limitation for a border, it is noted that the claim fails to provide any specific limitations directed to the recited border. As such, the adjacent piece such as element 2 to element 1 would provide a border therefore.

Regarding the reference to Wadsworth, the applicant argues that the pieces of Wadsworth do not provide marks having different orientations that correspond to possible orientations of the puzzle piece with respect to the border. However, this is not persuasive as the marks of Wadsworth will present different orientations as the piece is rotated. The rotation of the piece will present a corresponding different orientation of the marks with respect to the user.

The applicant argues that the marks are interrelated and thus have the same orientation. While the marks may be interrelated in forming the one picture, in solving the puzzle, the orientation of the marks will change upon the rotation of the piece itself within the border.

10. Regarding the remarks directed to the rejection under 35 U.S.C. 103, the applicant argues that the marks of Steinmann are not useful in characterizing a specific orientation of the card or block. However, this is not persuasive as the argument is based upon applicant's own subjective opinion and not supported by fact. The applicant appears to be arguing a difference in degree that is not presented in the claims. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized

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that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Allowable Subject Matter

11. Claim 7 appears to read over the prior art of record.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

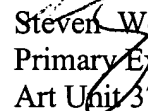
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
August 29, 2005